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In re application of

Kazuhiko HARA et al.

Serial No. 09/438,786 ✓

Filed November 12, 1999

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Docket No.00144/122111US

Group Art Unit 2861

Examiner K. Feggins

NOV-5 2001  
TECHNOLOGY CENTER 2800

INK-JET RECORDING APPARATUS

**REQUEST TO WITHDRAW THE FINALITY OF THE OFFICE ACTION**  
**MAILED OCTOBER 3, 2001 AND REQUEST**  
**FOR CLARIFICATION OF THE SAME**

Assistant Commissioner for Patents,  
Washington, D.C.

Sir:

This is a request that the finality of the Office Action mailed October 3, 2001 be withdrawn. It is Applicants' belief that the final rejection is premature and should be withdrawn.

In the Office Action of April 25, 2001, claims 1-4, 6-9, 11-14, 16-18 and 21-23 were rejected over the prior art. However, claims 5, 10, 15, 19 and 20 were indicated as being allowable if rewritten in independent form.

In the response filed July 31, 2001, claims 5, 10, 15, 19 and 20 were redrafted as new claims 28, 33, 38, 42 and 43. These new claims were drafted to place the claims in better U.S. form. The scope of claims 28, 33, 38, 42 and 43 is the same as that of original claims 5, 10, 15, 19 and 20. However, in the final Office Action mailed October 3, 2001, the Examiner has withdrawn the indication of allowability of claims 42 and 43.

MPEP 706.07(a) states that a final rejection is proper on a second or subsequent action on the merits, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c). Note that

the information relied upon by the Examiner was not submitted in an IDS during the period set forth in 37 C.F.R. § 1.97(c).

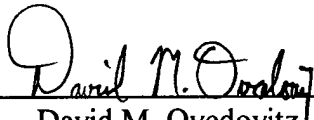
Not only is the Examiner introducing a new ground of rejection that was not necessitated by the amendment, the final rejection is the first time that claims 42 and 43 have been rejected. Note that rejecting previously allowed claims is not to be taken lightly, as indicated in MPEP 706.04, it is clear that such action cannot be taken in a final rejection.

In view of the fact that claims 42 and 43 are rejected for the first time in the Office Action of July 3, 2001, it is submitted that the finality of the previous Office Action is premature and must be withdrawn.

Further, the cover sheet indicates that claims 24-50 have been rejected. However, claims 28, 33 and 38 were not addressed in the final Office Action. Therefore, clarification of the status of these claims is also respectfully requested.

Respectfully submitted,

Kazuhiko HARA et al.

By:   
David M. Ovedovitz  
Registration No. 45,336  
Attorney for Applicants

DMO/jmj  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
November 2, 2001